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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,095	08/22/2003	Doron Friedman	F0011/7005	8394
21127 7590 07/23/2008 RISSMAN JOBSE HENDRICKS & OLIVERIO, LLP 100 Cambridge Street Suite 2101 BOSTON, MA 02114				
EXAMINER JEAN, FRANTZ B				
ART UNIT		PAPER NUMBER		
2154				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/646,095

**Applicant(s)**

FRIEDMAN ET AL.

**Examiner**

Frantz B. Jean

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-17,19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

This office action is in response to applicants' argument filed on 4/28/08. Claims 1, 3, 5-17 and 19-22 are still pending in the application. Claims 2, 4 and 18 have been canceled.

Applicants' arguments regarding the 101 rejection are not persuasive. Therefore, The rejection is still maintained.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claims 3-5 are directed to a computer program product comprising computer usable medium having program code embodied thereon. However, the specification defines the medium to be a carrier wave, which is not tangible. Therefore, it is concluded that claims 3-5 are non-statutory. Correction is required.

**During patent examination, the pending claims have been “given\* their broadest reasonable interpretation consistent with the specification.” In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-17 and 19-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Small US patent number 5,513,117.

As per claim 1, Small teaches In a computer system connectable to a computer network, a method comprising: (a) maintaining in a memory data defining a greeting card and any modifications thereto; (b) printing the greeting card in conjunction with any modifications thereto; (c) printing readable data on the greeting card; and (d) generating from the readable data printed on the greeting card any of a shipping label identifying at least one item to be shipped in conjunction with the printed greeting card (see fig 1-4 and 7-9;abstract; col. 2 line 30 to col. 3 line 59).

As per claim 3, Small teaches a computer program product for use with a computer system operatively coupled to a computer network comprises a computer usable medium having program code embodied thereon, the program code comprising: (a) program code for maintaining in a memory data defining a greeting card and any modifications thereto; (b) program code for printing the greeting card in conjunction with any modifications thereto; (c) program code for printing readable data on the greeting card; and (d) program code for generating from the readable data printed on the greeting card a document comprising a packing list identifying at least one item to be shipped in conjunction with the printed greeting card (see fig 1-4 and 7-9;abstract; col. 2 line 30 to col. 3 line 59).

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As per claim 5, Small teaches a computer program product of claim 3 wherein the document further comprises a shipping label identifying a destination of the printed greeting card (fig 6-7 and 9).

As per claim 6, Small teaches in a computer system connectable to a computer network, a method comprising: (a) providing a printed personalized greeting card having readable data printed thereon; (b) reading the reference data from the greeting card; (c) using the read data to access in memory data defining any of a greeting card destination address, SKU, and lot number identifying a gift with which the personalized greeting card will be shipped; (d) generating a label from the accessed data in memory (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 7, Small teaches a method of claim 6 wherein the label comprises a packing list identifying at least one item to be shipped in conjunction with the printed greeting card (fig 6-7 and 9; col. 7 lines 14 et seq).

As per claim 8, Small teaches a method of claim 6 wherein the label comprises a shipping label identifying a destination of the printed greeting card (fig 6-7 and 9).

As per claim 9, Small teaches a computer system of claim 6 wherein the reference data comprises a bar code identifying any of a destination address, SKU and lot number of a gift to be shipped with the greeting card (see fig 7, 9, 10-11 and 13; abstract; col. 2 line

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30 to col. 3 line 59).

As per claim 10, Small teaches a method of claim 6 further comprising: (e) maintaining in memory data representing any of a lot number identifying a gift with which the personalized greeting card will be matched, and a destination shipping address (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 11, Small teaches a computer system connectable to a computer network comprising: (a) a processor; (b) a memory coupled to the processor for storing data defining a card and any modifications thereto; (c) a printer coupled to the processor and memory for printing the card in conjunction with any modifications, and readable reference data thereon; and (d) program logic configured to read the reference data from the card and generate a label therefrom (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 12, Small teaches a computer system of claim 11 wherein the reference data is direct source of information for generating a shipping label containing at least a destination address to which the card will be sent (see fig 7, 9, 10-11 and 13).

As per claim 13, Small teaches a computer system of claim 11 wherein the reference data is usable to access a file containing the information for generating a shipping label containing at least a destination address to which the card will be sent (see fig 7, 9, 10-

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11 and 13).

As per claim 14, Small teaches a computer system of claim 11 wherein the reference data is a source of information for generating an intermediate label used for matching at least one item to be shipped with the card (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 15, Small teaches a computer system of claim 11 wherein the reference data is a source of information for generating any of a gift card, envelop and gift certificate to be shipped with the card (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 16, Small teaches In a computer system connectable to a computer network, a method comprising: (a) maintaining in a memory data defining a greeting card and any modifications thereto; (b) printing the data defining a greeting card and any modifications on paper stock to make an n panel greeting card, where n is greater than two; (c) printing readable data on one of the n panels of the greeting card, the readable data comprising data identifying a product with which the greeting card will be matched, and a destination shipping address (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 17, Small teaches In a computer system connectable to a computer

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network, a method comprising: (a) maintaining in a memory data identifying one of a plurality of document templates and any personalization modifications thereto; (b) printing a personalized document comprising the document template in conjunction with any personalization modifications thereto; (c) printing a data reference on the personalized document; and d) maintaining, in a memory, reference data representing one of data identifying a product with which the personalized document will be matched, and a destination shipping address (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 19, Small teaches a method of claim 17 wherein the reference data comprises a bar code (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 20, Small teaches a method of claim 17 further comprising: (e) generating from the reference data printed on the document one of a destination shipping label, envelop (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 21, Small teaches a method of claim 17 wherein the reference data comprises a packing list of at least one product to be shipped with the document (see fig 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

As per claim 22, Small teaches a method of claim 17 wherein the plurality of document



templates comprise any of greeting cards, promotional advertisements, and catalogs (see fig 1-4 and 7, 9, 10-11 and 13; abstract; col. 2 line 30 to col. 3 line 59).

***Response to Arguments***

Applicant's arguments filed on 04/28/08 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the gifts are not just gift certificates, but may be physical entities of different types. Further, the card and gift combination is not predetermined, i.e. the selected gift does not predefine or limit the selection of cards, nor does the selected card predefine or limit the selection of gift(s). Accordingly, the present invention allows any number of independently selectable, cards to be customizable and matched with any number of selectable gifts, without predetermined limitations, and for the customized card and gift(s) to be sent together as a single combined entity to the designated recipient. As set forth in the subject application, the readable data printed on the personalized greeting card may function as a shipping label in the fulfillment environment to match a gift with a card. Alternatively, such readable data may be utilized to generate an intermediate label, such as a pick ticket, useable to help match the printed greeting card with another item in the fulfillment warehouse. In this matter, the personalized greeting card itself becomes a mechanism for facilitating the matching of a gift with the card; see par 1 at page 8 of applicants' arguments) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Small does not teach certain limitations, examiner submits that the arguments at par 1 of page 8 reflect intended use. Applicants are cautioned that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Therefore, contrarily to applicants' assertion that Small does not teach certain features of the invention, Examiner submits that Small teaches all the concepts and aspects of the invention as claimed (see detailed rejection above). Examiner believes the claims are still broadly written; therefore, they are not defined over the prior art of record to Small. Accordingly, the rejection is maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantz B. Jean/  
Primary Examiner, Art Unit 2154